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EXAMINER

PIERCE, WILLIAM M

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal 2009-011015
Application 10/604,853
Technology Center 3700

Decided: June 22, 2010

McCARTHY, *Administrative Patent Judge.*

STATEMENT OF THE CASE

2 The Appellants appeal under 35 U.S.C. § 134 from the Examiner's
3 decision finally rejecting claims 1-4, 6-16, 18, 19 and 21-33 under 35 U.S.C.
4 § 102(b) as being anticipated by Calentine (US 4,062,540, issued Dec. 13,

1 1977); and finally rejecting claims 5, 17 and 20 under 35 U.S.C. § 103(a) as
2 being unpatentable over Calentine and Pugh (US 3,728,736, issued Apr. 24,
3 1973).¹ In the Answer, the Examiner withdrew rejections of claims 2, 3, 15
4 and 20-33 under 35 U.S.C. § 101 as being directed to non-statutory subject
5 matter as well as rejections of claims 2, 3, 15 and 20-33 under 35 U.S.C.
6 § 112, second paragraph, as being indefinite. We have jurisdiction under 35
7 U.S.C. § 6(b).

8 We AFFIRM.

9 Before discussing the merits of the rejections of claims 1-33, we
10 briefly address the state of the record. The Appellants filed Appellants'
11 Appeal Brief October 31, 2005 and supplemented the Appeal Brief on
12 January 26, 2009. The Examiner mailed an Answer on September 13, 2007
13 and supplemented the Answer on January 21, 2009.

14 The Appellants filed a Reply Brief on September 24, 2007. The
15 Examiner refused entry of the Reply Brief on January 21, 2009 because the
16 proffered Reply Brief included new or non-admitted evidence, namely,
17 Schaffer (US 4,371,163, issued Feb. 1, 1983). *See* 37 C.F.R. §§ 41.41(a)(2)
18 and 41.41(b) (2005). The Appellants filed a second Reply Brief on January
19 26, 2009. The Examiner declined to enter the second Reply Brief because

¹ Although the Examiner denominated the rejections of claims 5, 17 and 20 as being over Calentine alone, the Examiner cited Pugh as evidence supportive of the existence of an apparent reason for modifying the teachings of Calentine in the fashion claimed. (Final Rejection, mailed Jul. 25, 2005 at 4). Since the Appellants argued the rejections as being based on the combined teachings of Calentine and Pugh (*see* App. Br. 25), we have considered the teachings of Pugh together with those of Calentine in reviewing the rejections of claim 5, 17 and 20 under § 103(a). *See In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970).

1 the second proffered Reply Brief was non-responsive to the refusal to enter
2 the first proffered Reply Brief.

3 The Examiner's refusal to enter the two proffered Reply Briefs is
4 subject to review by petition rather than by a panel of the Board. *Cf. In re*
5 *Mindick*, 371 F.2d 892, 894 (CCPA 1967)(holding that an examiner's refusal
6 to enter an amendment after final rejection is subject to review by petition
7 and not by a panel of the Board). For this reason, we have not considered
8 any arguments made by the Appellants in either of the proffered Reply
9 Briefs that were not made in the Appeal Brief.

10 In the Final Office Action mailed July 25, 2005, which will be
11 referred to as "Final Rejection," the Examiner rejected claims 1-4, 6-16, 18,
12 19 and 21-33 under § 102(b) as being anticipated by Calentine. Claim 1 is
13 illustrative of the appealed claims:

14 1. A system of interlocking surfaces on bowler's
15 finger pad cover and on a bowling ball finger hole
16 insert for producing a force to counteract shifting
17 of the ball relative to the bowler's finger pad and
18 the contact area made between the finger pad cover
19 and the finger hole insert, comprising:

20 a. first means for mounting an interlocking three
21 dimensional surface on a finger pad;

22 b. second means for mounting an interlocking
23 three dimensional surface on the finger hole of a
24 bowling ball;

25 c. said first and second means for co-acting to
26 produce a counter force opposed to movement of
27 said first means relative to said second means.

28 In the Final Rejection, the Examiner identified structure in Calentine
29 corresponding to the first and second means recited in claim 1. The

1 Examiner further concluded that structure described in Calentine was
2 substantially identical to the claimed structure, giving rise to an unrebutted
3 rebuttable presumption that the first and second means in the structure
4 described by Calentine necessarily had the property of being capable of co-
5 acting in the manner recited in clause “c” of claim 1. (Final Rejection 3-4).

6 In the Answer, the Examiner identified different structure in Calentine
7 corresponding to the second means recited in claim 1. (Ans. 3). Instead of
8 relying on the rebuttable presumption that the first and second means in the
9 structure described by Calentine necessarily had the property of being
10 capable of co-acting in the manner recited in clause “c” of claim 1 due to
11 substantial structural identity, the Examiner introduced an explanatory
12 reference as evidence that the first and second means in the structure
13 described by Calentine necessarily had this property. (Ans. 4).

14 The thrust of the rejections of claims 1-4, 6-12, 14-16, 18, 19, 21-26,
15 28-30, 32 and 33 under § 102(b) as being anticipated by Calentine changed
16 sufficiently between the Final Rejection and the Answer that the rejection in
17 the Answer constituted new grounds. *Cf. In re Kronig*, 539 F.2d 1300, 1303
18 (CCPA 1976)(holding that the Board’s reasoning did not constitute a new
19 ground of rejection where “the basic thrust of the rejection at the examiner
20 and board level was the same.”). The Appellants were not advised that new
21 grounds of rejection had been entered and that the entry of the new grounds
22 of rejection might impact the effect of failing to file a compliant Reply Brief.
23 For this reason, we exercise our discretion to disregard the new grounds of
24 rejection and the new explanatory reference entered in support of the new
25 grounds of rejection. We review and sustain the rejections of claims 1-4, 6-
26 16, 18, 19 and 21-33 under § 102(b) as set forth in the Final Rejection.

1 In the Final Rejection, the Examiner rejected claims 13, 27 and 31
2 under § 102(b) as being anticipated by Calentine. In the Answer, the same
3 claims were rejected instead under § 103(a) as being unpatentable over
4 Calentine. This change in the thrust of the rejections of claims 13, 27 and 31
5 also constitutes new grounds of rejection. We exercise our discretion to
6 disregard the new grounds of rejection. We review and sustain the rejections
7 of claims 13, 27 and 31 under § 102(b) as set forth in the Final Rejection.

8
9 ISSUES

10 The Examiner has aptly summarized the positions taken in the
11 Appellants' Appeal Brief and the Examiner's Answer regarding the
12 rejections under § 102(b):

13 Appellant[s'] arguments on pgs. 20-25 [of
14 the Appeal Brief] amount to a general allegation
15 that the claims define a patentable invention
16 without specifically pointing out how the language
17 of the claims patentably distinguishes them from
18 the references. Instead, [Appellants reprint] copies
19 of the claims with underlined portions and [state]
20 that such [that is, the underlined claim language] is
21 not shown. . . . Examiner's position with respect to
22 each limitation in the claims is explicitly set forth
23 above in the Grounds for Rejection.

24 (Ans. 13).

25 With respect to the rejections of claims 5, 17 and 20 under § 103(a),
26 the Examiner's Answer concludes that,

27 while Calentine fails to show covering of the
28 finger tip, finger tip gloves and gloves without
29 finger tip[s] are well known depending upon the
30 users desired amounts of protection. In bowling,
31 full finger inserts are known as shown by Pugh.

1 To have included a means for covering the finger
2 tip of Calentine would have been obvious in order
3 to afford protection to the fingertip during
4 bowling.

5 (Ans. 11). The Appellants argue in the Appeal Brief that:

6 The reason given for rejection, that it would have
7 been obvious, is a conclusion without any support
8 in record fact and does not explain how Pugh or
9 Calentin[e], teaches or discloses any claimed
10 combination. . . . There is no competent record
11 evidence showing any teaching of combining any
12 element of Pugh with the elements of the recited
13 claimed invention of claims 5, 17, and 20.

14 (App. Br. 25).

15 Only issues and findings of fact contested by the Appellants have
16 been considered in this opinion. *See Ex Parte Frye*, 94 USPQ2d 1072,
17 1075-76 (BPAI 2010). This Appeal turns on two issues:

18 *First*, has the Examiner shown where Calentine discloses
19 limitations of claims 1-4, 6-16, 18 and 21, underlined in those
20 claims as reproduced in pages 20-23 of the Appeal Brief?²

21 *Second*, has the Examiner articulated reasoning with
22 some rational underpinning sufficient to support the conclusion
23 that the subject matter of claims 5, 17 and 20 would have been
24 obvious?

² The Appellants also argue that Calentine “does not disclose the recited elements of method claims 22 to 23, dependent from claim 21 or the system claims 24 to 33.” (App. Br. 24). This statement lacks sufficient specificity to determine the errors which the Appellants perceive in the rejections of these claims. Furthermore, since nothing is underlined in claim 19 as reproduced on page 23 of the Appeal Brief, it is presumed that the Appellants intended claim 19 to stand or fall with its parent claim 14.

FINDINGS OF FACT

We adopt and incorporate by reference the Examiner's findings at page 3, lines 18-26 of the Final Rejection. We also adopt and incorporate by reference the Examiner's findings (*see* Final Rejection at 4) that "[f]inger tip gloves and gloves without finger tip[s were] well known depending upon the user[']s desired amounts of protection. In bowling full finger inserts [were well] known as shown by Pugh."

We adopt and incorporate by reference the Examiner's findings at page 4, line 7 through page 7, line 6; page 7, line 9 through page 8, line 5; and page 8, lines 11-14 of the Answer.

We agree with the Examiner that use of the structure described by Calentine necessarily would produce the counterforce recited in clause "c" of claim 1 and further limited in claims 2 and 3. Figures 4a-4c of the Appellants' drawings depict an example of co-acting or interlocking three dimensional surfaces on the inner surface 14 of a finger hole insert 12 and on a finger pad cover 31. The example includes first means, namely, the finger pad cover 31, for mounting an interlocking three dimensional surface 35 including hemispheric protrusions 49a and 49b' on the finger pad cover 31; and a second means, namely, a bowling ball 10 with a finger hole insert 11 inserted in a finger hole 12, for mounting an interlocking three dimensional surface 15 including hemispheric depressions 49a and 49b on the finger hole 12 of the bowling ball 10. (Spec., ¶ 0038; *see also* App. Br. 1-2 (identifying structure described in the Specification corresponding to the first and second means)).

The Examiner finds that Calentine discloses first means, namely, a thumb piece 10, for mounting an interlocking three dimensional surface,

1 namely, the three dimensional surface of the finger pad or thumb piece 10
2 including frictional inserts 28, 30, shown as hemispheric in the drawing
3 figures, on the thumb piece 10; and a second means, namely, a bowling ball
4 18 with a finger hole insert or sleeve 14 inserted in a finger hole or thumb
5 hole 16, for mounting an interlocking three dimensional surface of the sleeve
6 14 including a circumferentially disposed slot 70 on the thumb hole 16 of the
7 bowling ball 18. (Ans. 3; *see also* Calentine, col. 4, ll. 50-57 and col. 5, ll.
8 29-39). Based on these facts, the Examiner correctly found (*see* Ans. 3) that
9 the first and second means disclosed by Calentine are at least substantially
10 identical to the first and second means recited in claim 1.

11 “Where, as here, the claimed and prior art products are identical or
12 substantially identical, . . . the [Patent and Trademark Office] can require an
13 applicant to prove that the prior art products do not necessarily or inherently
14 possess the characteristics of [the applicant’s] product.” *In re Best*, 562 F.2d
15 1252, 1255 (CCPA 1977). One such characteristic which may be shown to
16 be inherent in a prior art product is the capacity to perform a function. Thus:

17
18 where the Patent [and Trademark] Office has
19 reason to believe that a functional limitation
20 asserted to be critical for establishing novelty in
21 the claimed subject matter may, in fact, be an
22 inherent characteristic of the prior art, it possesses
23 the authority to require the applicant to prove that
24 the subject matter shown to be in the prior art does
25 not possess the characteristic relied on.
26

27 *Id.* at 1254-55 (quoting *In re Swinehart*, 439 F.2d 210, 212-213 (CCPA
28 1971)).

1 Here, the Examiner properly found that the first and second means
2 disclosed in Calentine were substantially identical to the first and second
3 means recited in claim 1. Based on this finding, the Examiner inferred that
4 the first and second means disclosed in Calentine were capable of
5 performing the same functions performed by the first and second means
6 recited in claim 1, namely, the function recited in clause “c” of claim 1 and
7 further limited in claims 2 and 3. The Examiner as fact-finder placed the
8 Appellants on notice that this inference shifted the burden of producing
9 evidence to show that the first and second means disclosed by Calentine
10 were incapable of performing this function. (Final Rejection 3-4). The
11 Appellants did not respond with either argument or additional evidence
12 persuasive that the inference was improper. For these reasons, we adopt the
13 Examiner’s inference as fact. For similar reasons, we agree with the
14 Examiner that Calentine discloses “means for developing a counter force to
15 a force intersecting with said longitudinal axis” as recited in claim 15.

17 ANALYSIS

18 *First Issue*

19 The Appellants contend that the Examiner has not shown where
20 Calentine discloses limitations of claims 1-4, 6-16, 18 and 21 underlined in
21 those claims as reproduced in pages 20-23 of the Appeal Brief. The
22 Examiner details findings concerning where Calentine discloses these
23 limitations at page 3, lines 18-26 of the Final Rejection as well as at page 4,
24 line 7 through page 7, line 6; page 7, line 9 through page 8, line 5; and page
25 8, lines 11-14 of the Answer. The Appellants provide no persuasive reason
26 why these findings might be incorrect.

1 *Second Issue*

2 The Appellants contend that “[t]he reason given for rejection, that it
3 would have been obvious, is a conclusion without any support in record fact
4 and does not explain how Pugh or Calentin[e], teaches or discloses any
5 claimed combination.” (App. Br. 25). In order to establish a prima facie
6 case that a claim is obvious based on teachings of prior art references, the
7 Examiner also must articulate some “reasoning with some rational
8 underpinning to support the legal conclusion of obviousness.” *In re Kahn*,
9 441 F.3d 977, 988 (Fed. Cir 2006). This “reasoning with some rational
10 underpinning” must identify some apparent reason for combining the prior
11 art elements in the fashion claimed. The use of common sense as a
12 component of the apparent reason for combining the prior art elements “does
13 not require a ‘specific hint or suggestion in a particular reference,’ only a
14 reasoned explanation that avoids conclusory generalizations.” *Perfect Web*
15 *Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009)(quoting
16 *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1366 (Fed.
17 Cir. 2006)).

18 The apparent reason proposed by the Examiner for having combined
19 the teachings of Calentine and Pugh is not conclusory. The reasoning
20 articulates a matter of common sense, namely, that it was desirable to afford
21 protection to the fingertip during bowling, which together with the teachings
22 of Pugh bridges the differences between the claimed subject matter and the
23 prior art. The apparent reason proposed by the Examiner is valid even
24 assuming, as the Appellants appear to argue, that neither Calentine nor Pugh
25 has an express teaching to modify Calentine’s structure as claimed in claims
26 5, 17 and 20.

CONCLUSIONS

The Examiner has shown where Calentine discloses limitations of claims 1-4, 6-16, 18 and 21, underlined in those claims as reproduced in pages 20-23 of the Appeal Brief.

The Examiner has articulated reasoning with some rational underpinning sufficient to support the conclusion that the subject matter of claims 5, 17 and 20 would have been obvious.

We sustain the rejections of claims 1-4, 6-16, 18, 19 and 21-33 under 35 U.S.C. § 102(b) as being anticipated by Calentine and the rejections of claims 5, 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Calentine and Pugh.

DECISION

We AFFIRM the decision of the Examiner to reject claims 1-33.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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